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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,246	09/26/2001	F. William Daugherty	102.006	8590
8791 7590 08/23/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 08/23/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/963,246	DAUGHERTY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey D. Carlson	3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. In view of the supplemental appeal brief filed on 11/22/2006, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are additionally set forth below. To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



Eric Stamber

Supervisory Patent Examiner

### ***Claim Objections***

2. Claim 1 is objected to because of the following informalities:

- Claim 1 (ii) recites "a selection of said one plurality" which is apparently supposed to read --a selection of one of said plurality--.

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- Claim 15 is an improper dependant claim, failing to further limit the parent claim. The feature of claim 15 is already present in claim 11.
- Claim 18 is an improper dependant claim, failing to further limit the parent claim. The feature of claim 18 is already present in claim 17.

Appropriate correction is required.

### ***Specification***

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- Several of the claims recite limitations associated with a third party, yet such a term does not appear in the specification.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 1, 17, 21, 25 each sets forth a method claim which is taken to represent a single usage example of the disclosed invention. Applicant's language that the associated delivery process *differs* for each option and

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receiving input *differing* depending on the selection is confusing. How can a single usage example set forth limitations regarding how the steps performed taken differ from steps that could have been performed but were not performed ? Applicant should repeat the process claim 1 with a second different usage example if applicant intends to clearly set forth differing steps/branches of a flowchart. Without such addition, it is not clear how a performed step can differ from anything.

- Claims 4, 11 depend from claim 1 which positively requires “providing information associated with said advertisement”. Yet these claims attempt to further define the step of providing information as a step of indicating that the information will be provided. This portion of these claims is confusing in scope as it appears that the actual providing of the information is not positively required by the claim(s),
- Claim 7, it is unclear what step is being further limited. Perhaps applicant should be further limiting a step of *selecting* which of a plurality of delivery processes to perform based on the personal information.
- Claim 20, it is unclear what the difference is between an image, a badge and a banner, making the claim’s scope uncertain.
- Claim 20 it is unclear how the displayable item which has plural selectable options can be an image, a hyperlink, banner, button or a badge. It is unclear how an image can have 2 selectable options. It is unclear how a hyperlink can have 2 selectable options. It is unclear how a banner can have 2

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selectable options. It is unclear how a button can have 2 selectable options.

It is unclear how a badge can have 2 selectable options. Perhaps applicant should claim that these items are displayed next to the options, rather than as the options.

- Claims 6, 21 include a reference to a third party, yet it is not clear who the first or second parties are. Without such clarification, the claims appear to only require simply "a party".
- Claim 24 states that contact information may include: an email address, postal address, telephone number or fax number which is fine. However the claim also states contact information as: a user preference, credit card number or user identifier, yet none of these three pieces of information are in fact contact information.
- Claims 26, 27 set forth a system (i.e. apparatus) with a means for distributing an ad having plural selectable options. This is fine, however the claim continues by stating that "each option has an associated delivery process", which is unclear. Is this intended use or is applicant setting forth some specific structure by this language? What system structure is responsible for providing the associated delivery process? It appears that applicant is trying to limit an entry field by how applicant intends to respond to the entered information. This of course is not a characteristic of the entry field, but rather intended use. The claim ends with "means for transmitting...via said delivery proves" which is also unclear. What system structure is responsible for

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providing this means for transmitting? Applicant's disclosed delivery options of a postal delivery or telephone call do not seem to be provided by any particular structure, but rather are simply manual steps applicant chooses to perform depending on the option selected and user input. Applicant's system apparatus as disclosed appears to be limited to presentation of options and collection of a user choice and their input; the delivery process appears to require manually performed steps which cannot be claimed as part of an apparatus claim.

***Claim Rejections - 35 USC § 101***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 101 that form the basis for the rejections under this section made in this Office action:

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 27 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- Claim 27 is taken to present programming *per se*. Applicant should amend the preamble to include computer instructions on a computer readable medium that are capable of being executed by a processor.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 1-10, 12, 17-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg (US6330243).**

Regarding claims 1, 2, 4, 17-20, 26, 27, Stranberg teaches that it is well known for consumers to request product information from a business via the World Wide Web and for the business to provide a field for the inquiring party to provide a telephone number where they can be contacted for further information and follow-up [col 1: lines 28-46]. Stranberg also teaches the concept of a user accessing a webpage from a website via a web browser where the webpage can include various content such as text, images, audio, video, etc. as well as an HTML-based user interface with data entry capability. The HTML interface serves to advertise that more information about a product/service is available upon request and is therefore taken to meet the broad term "advertisement" as well as the term "item" [col 5: lines 7-8, lines 16-35]. The data entry fields of the interface are designed to elicit responses to requests for product information as is well known in the art" [5:24-26]. Such requests can include name, telephone, address, information desired, product inquiries or any other information useful for sales and/or marketing purposes [5:27-31]. While Stranberg admits it is known to contact an inquiring consumer via a submitted telephone number in order to provide the requested



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product information, Stranberg is silent on whether to contact the inquiring consumer according to the other collected information fields such as address. However, It would have been obvious to one of ordinary skill at the time of the invention to have provided any number of plural contact field options (postal mail, FAX, telephone, email, etc. as they are well known methods of communication), to have collected the appropriate number, address, email, etc. and to have contacted the inquiring party by such requested communication channels in order to deliver the desired product information. Doing so would allow consumers to receive the requested information in a format they find most comfortable, digestible and convenient. Each of the plural fillable fields of Stranberg's interface is taken to represent a "selectable" option.

Regarding claim 3, receiving a FAX, email, telephone call, postal mailing, etc inherently represents receiving an indication of personal information used to make such communication contact.

Regarding claims 5, 9, any of the received information about the consumer is taken to be personal information.

Regarding claims 6-8, 10, providing a parcel/letter to the US Postal Service for example for delivery to the identified recipient is taken to be providing a third party with the personal/contact information of the consumer as well as an indication of the consumer's choice to have a postal delivery for them.

Regarding claim 12, it would have been obvious to one of ordinary skill at the time of the invention to have asked for consent to send future communications to the

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consumer in order to deliver future promotional materials as is well known. Doing so would serve to create a long-term relationship with the consumer.

Regarding claims 21-24, and the "third-party" language, the website providing the product information and user form to request information can be taken to be the third party, while the consumer is taken to be a first party and the consumer's ISP for example could represent a second party, enabling access to the Internet and the third-party website. A consumer choosing the selectable option of a telephone number provides the steps of providing to the third party an indication of the selection and the requested delivery process.

Regarding claim 25, a consumer requesting information to be sent to his email address meets the claim in the case where the consumer reads his email via a website (webmail client). Official Notice is taken that webmail (such as Yahoo mail and Microsoft's hotmail) has been around for years. It would have been obvious to one of ordinary skill at the time of the invention to have checked the consumer's email from such a webmail service. Reading an email on a webmail site about requested product information can be said to represent an indication of the email-selection as the delivery method.

**9. Claims 11, 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg in view of Patterson (US2003/0028608).**

Regarding claims 11, 14-16, Patterson also teaches a user of a webpage filling out a text field with contact information so that the business who is advertising can

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contact that consumer through the specified communication channel and unique communication address provided [para 0026]. Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028]. It would have been obvious to one of ordinary skill at the time of the invention to have provided a confirmation notice that the information will be provided via the communication channel, such as for example by third party US Postal Service.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.

**10. Claims 6, 10, 11, 13-16, 21-25 are alternatively rejected under 35 U.S.C. 103(a) as being unpatentable over Stranberg in view of Patterson and/or Patterson in view of Stranberg.**

Regarding claims 6, 10, 21-25, Patterson teaches that a consumer (i.e. first party) can visit a first website (i.e. second party) which can include not only content about the first business, but also a banner advertisement from a second business (i.e. third party). The advertisement is taught to include a request form that the user can fill out such as "send me information on golf clubs" [para 0026]. The form can collect the user's email address as contact information as well as userID [para 0037]. It would have been obvious to one of ordinary skill at the time of the invention to have provided the plurality of contact options in a manner made obvious by Stranberg with the third party advertisement of Patterson. Doing so would enable web surfers at many various

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websites to see and request the product information of Stranberg; this provides wider exposure for the third party. A consumer filling out a particular selectable option with his personal contact information results in an indication to the third party of the consumer's desire for information and the requested delivery channel and would trigger the delivery of such information via the proper communication channel (email, telephone, FAX, postal mail, etc.).

Regarding claims 11, 14-16, Patterson also teaches that a confirmation message can be provided so that the user is made aware of a successful submission [para 0028, figure 4]. This message serves to indicate that the third party will be delivering the requested information.

Regarding claim 13, providing contact information to the website is taken to provide consent for contacting the consumer.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc